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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,709	04/30/2001	Mohan L. Sanduja	1067-107	3925

7590 10/04/2002  
NIXON & VANDERHYE P.C.  
1100 North Glebe Road, 8th Floor  
Arlington, VA 22201

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 10/04/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/844,709

Applicant(s)

SANDUJA ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05/30/01; 07/25/01; 08/10/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 17-25 and 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-16, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

**Information Disclosure Statement**

1. *The information disclosure statements filed 05/30/01 & 08/10/01 have been considered and placed in the application file.*

**Election/Restrictions**

2. *Applicant's election of the Group II(claims 8-16, 26 & 27) invention in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, claims 1-7, 17-25 and 28-33 stand withdrawn from consideration by the Examiner as per having been drawn to a non-elected invention.*

**Claim Rejections - 35 USC § 112**

3. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

4. *Claims 8-16, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

A) *The recited contents per claims 8, 9, 26 and 27 constitute indefinite subject matter as per it not being readily ascertainable as to the exact entity that said contents are being based on, i.e., total coating composition or else.*

B) *The recited "about less than" per claims 8, 9, 15, 26 and 27 constitutes indefinite subject matter as per the metes and bounds of said phrase engender an indeterminacy in scope.*

C) *The recited monomer ester" per claim 26 engenders awkwardly expressed claim language. Use of "ester monomer" is suggested in lieu of "monomer ester" so as to engender claim language clarity.*

**Claim Rejections - 35 USC § 102**

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**5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

***A person shall be entitled to a patent unless –***

***(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.***

**6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.***

**7. Claims 8-16, 26 and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Magat et al(U.S. 3,514,385), Yoshida et al(U.S. 3,986,875) or Liao et al(U.S. 5,387,318) .**

***Magat et al disclose solutions of an organic compound, applied to a textile substrate, wherein said solutions are defined basically as containing ethylenically unsaturated monomers which include (meth)acrylamide, (meth)acrylic acid esters, salts and esters of sulfonic acid, etc., non-polymerizable compounds which include water and/or alcohols, polymeric modifiers which include polyacrylamide, etc. See, e.g., the Abstract, cols. 1, 3, 9-13 and the Runs of Magat et al. Yoshida et al disclose image receiving layers comprising a spacer layer which comprises a solution, in a water/alcohol admixture, of mono(meth)acrylates/other comonomers grafted to polyacrylamide. See the paragraph bridging cols. 3 to 4 and col. 4 of Yoshida et al.***

***Liao et al teach graft copolymers, useful for water treatment, wherein the graft copolymer comprises a macromonomer of acrylamide, vinyl monomers which include polyethylene glycol di(meth)acrylates, etc. + a branching agent which includes lower alcohols such as isopropanol and other conventional adjutants such as water. See, col. 4 and the Runs of Liao et al.***

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*Each of Magat et al, Yoshida et al and Liao et al therefore anticipate the instantly claimed invention with the understanding that the components of each of patentees overlaps in scope with the claimed components, in both content and character, with the understanding that "about less than" includes "zero" .*

*As to the dependent claims, the limitations are either taught by patentees, suggested by patentees or would have been obvious too the skilled artisan and with a reasonable expectation of success. The discovery of a new property or use for a previously known compound cannot impart patentability to claims to that compound, even if the property or use is unobvious(In re Schoenwald, 22 USPQ 1671).*

#### **Conclusion**

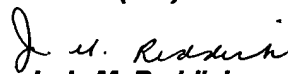
*8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.*

*9. The additional prior art listed on the FORM PTO-892 is cited as of being of interest in teaching compositions similar to those as claimed and is considered merely cumulative to the prior art supra.*

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

  
Judy M. Reddick  
Primary Examiner  
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**JMR** *JMR*  
**September 30, 2002**